

Serial No. 10/612,091
Art Unit 1773

Amendment A

Remarks:

In response to the Official Action mailed May 18, 2005, Applicant respectfully requests reconsideration, reexamination and allowance of claims 1, 4-7, and 9-20 in view of the above amendments and the following remarks.

First, Primary Examiner Jackson has rejected claims 19-20 under 35 U.S.C. §112, first paragraph as based on a disclosure which is not enabling. The Examiner has taken the position that the sealant material described in claim 1 is critical or essential to the practice of the invention but is not included in the claims and is not enabled by the disclosure. The Examiner states that from the disclosure the core of the invention is centered around the sealant composition but that claims 19-20 do not include the composition. For support of this rejection, the Examiner cites *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Applicant respectfully traverses this rejection. It is applicant's position that claims 19 and 20 stand on their own, and are fully in comport with §112 first and second paragraphs. The specification enables one skilled in the art to make and use (e.g., carry out) the invention as set forth in claims 19 and 20. That is, with the specification in hand, a skilled artisan can make and use the method of sealing a first component to a second component in which a premold of sealant material is disposed around at least a portion of the first component (such that the premold is formed into a desired shape) and the second component is overmolded over the first component and the premold of sealant material. The specification plainly enables carrying out this method.

The present situation is clearly distinguishable from the facts of the *Mayhew* case. Specifically, in *Mayhew*, a necessary *process step* and *location for carrying out that process step* were left out of the claims on appeal. The Court sustained the rejection of those method claims because the *process itself* was only enabled with that step carried out at that location. In the present application, no such limitations from the method are missing from the claims. Rather, the method claims stand on their own and no missing *process* or *method* elements are missing from the claims. Accordingly, Applicant respectfully requests that Examiner Jackson withdraw the §112 first paragraph rejection of claims 19-20 because these claims are, in fact, supported by

Serial No. 10/612,091
Art Unit 1773

Amendment A

a fully enabling disclosure.

Next, claims 1-18 have been rejected under 35 U.S.C. §112, second paragraph in that the concentrations of the various components are not recited with reference to a basis substance.

Applicant recognizes this concern and has amended the claims, as appropriate, to indicate that the concentration percentages are relative to the sealant material. Accordingly, the term of the sealant material has been inserted into each of the claims following the word "percent" as appropriate. Applicant submits that the Examiner's concerns have been addressed by this amendment and requests that this basis for rejection be withdrawn.

Next, the Examiner has rejected claims 1-4 and 7-8 under 35 U.S.C. §102(b) as anticipated by Knight et al., U.S. Patent No. 4,619,848. The Examiner has also rejected claims 1-5 and 7-9 under 35 U.S.C. §102(b) as anticipated by Willett et al., U.S. Patent No. 6,136,398.

The Examiner has also rejected claims 19 and 20 under 35 U.S.C. §103(a) as unpatentable over German document DE4109397 and has rejected claims 1-18 under 35 U.S.C. §103(a) as unpatentable over the German '397 document in view of Willett and in further view of Knight or Gerace, U.S. Patent No. 5,223,106 or Siadat et al., U.S. Patent No. 4,560,579.

Applicant has amended independent claims 1 and 10 to better define the sealing element as formed from a desirably shaped body of a sealant material, in which the sealant material is formulated from a first polymer that is an ethylene vinyl acetate copolymer in a concentration of about 25 percent to about 40 percent of the sealant material, an inert filler material in a concentration of about 20 percent to about 45 percent of the sealant material, a second polymer that is an ethylene polymer other than an ethylene vinyl acetate copolymer in a concentration of about 20 percent to about 35 percent of the sealant material and a hydrocarbon resin in a concentration of about 1 percent to about 15 percent of the sealant material. In such a sealing element, the sealant material, when positioned about a first component is overmolded with a material forming a second component. The sealant material, which is heat activated, forms a seal between the first and second components.

Applicant submits that the specific combination of materials in the recited concentrations

Serial No. 10/612,091
Art Unit 1773

Amendment A

(relative to the sealant material) are not disclosed in the art of record individually or in any combination, for the purposes of forming a sealing element between two components.

Without even a detailed analysis of the specific formulations disclosed in Knight, this patent makes no mention of a sealing material disposed about a first component with a second component *overmolded* about the sealing material (essentially, the sealing material being disposed between the first and second components with the second component molded over the sealing material and first component). As such, it is Applicant's position that Knight cannot anticipate the present claims (as amended), and this rejection should be withdrawn.

As to the German '397 document, this document fails to disclose the specific, recited formulation of the claimed sealing material (with reference to the rejection of claims 1-18) as well as fails to disclose the specifically claimed method (in claims 19-20) for sealing a first component to a second component.

Likewise, the Willett patent fails to make any mention of an overmolding of a second component on a first component with a sealing material between the components, and the Gerace and Siadat patents fail to disclose the claimed formulation.

Accordingly, Applicant submits that claims 1, 4-7, and 9-20 are allowable over the art of record and are fully in comport with §112 and respectfully and earnestly solicits early indication of same.

Serial No. 10/612,091
Art Unit 1773

Amendment A

Should the Examiner believe that a telephone interview would expedite prosecution and allowance of the present application, or address any outstanding formal issues, she is respectfully requested to contact the undersigned.

Respectfully submitted,

ILLINOIS TOOL WORKS INC.

By 

Paul F. Donovan
Reg. No. 39,962

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ILLINOIS TOOL WORKS INC.

3600 West Lake Avenue

Glenview, Illinois 60025

(847) 657-4075 Telephone

(847) 724-4160 Facsimile